## REMARKS

Claims 1-37 are pending. Claims 1-10 and 18-24 are withdrawn from consideration. Claims 11-17 and 25-37 stand rejected. Applicants respectfully request reconsideration of the pending rejection based on the following remarks.

Rejection Over Joao

The Examiner rejected claims 11-17 and 25-37 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,283,761 to Joao (the Joao patent). In particular, the Examiner asserts that the Joao patent discloses all of the claim elements. Applicants maintain that the Joao patent simply does not render Applicants' claimed invention prima facie anticipated since the Joao patent does not teach all of the claim elements. Applicants respectfully request reconsideration of the rejection based on the following comments.

With all due respect, the '761 Joao patent simply is not prior art. The Examiner asserts at page 3 of the present office action that the rejection is supported by the parent application. However, the parent application has issued as a patent, U.S. 5,961,332. If the Examiner maintains that the parent application supports the rejection, the analysis would be much simpler if the Examiner referred to the '332 patent for support of the rejection. The disclosure in the '332 parent application is extremely different from the disclosure of the '761 patent. While the Examiner says that there is no requirement to assert that the parent supports the rejection, Applicants pointed to two sections of the MPEP (2136.02 and 2136.03) that support such a requirement. Applicants apologize for inadvertently listing MPEP 2131.03 instead of 2136.03 in the last response. In particular, the Examiner has a burden to assert a prima facie case for unpatentability, which can only be established with prior art.

Even if the '761 Joao patent is prior art (which it is not), the '761 Joao patent does not prima facie anticipate Applicants' claimed invention. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (MPEP §2131). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (MPEP §2131). "Every element of the claimed invention must be literally present, arranged as in the claim. **The identical invention must be shown in as complete detail as is contained in the patent claim.**" Richardson v. U.S. Suzuki Motor Corp., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)(Internal citations omitted, and emphasis added.); see also MPEP 2131. "Here, as well, anticipation is **not** shown by a prior art disclosure which is only '**substantially the same**' as the claimed invention." Jamesbury Corp. v. Litton Industrial Products, Inc., 225 USPQ 253, 256 (Fed. Cir. 1985)(emphasis added).

The Examiner points to column 36, lines 45-63 of the Joao patent for disclosure of the evaluation and update of a treatment protocol. However, "update" implies that a treatment protocol existed prior to the evaluation. As disclosed in the Joao patent at column 36, lines 45-63, a treatment protocol is proposed by the computer and selected by a health care professional. Thus, nothing is performed automatically, and the Joao processor does not perform an "update." Since the Joao patent does not describe an update of a treatment protocol or a procedure that is performed automatically, the Joao patent clearly does not teach all the elements of Applicants claimed invention in the details described. Since the Joao patent does not teach all of the elements of Applicants' claimed invention, the Joao patent does not prima facie anticipate Applicants' claimed invention. Similarly, the Joao '332 patent does not seem to teach all of the elements of Applicants' claimed invention.

Since the Joao patent does not prima facie anticipate Applicants' claimed invention, Applicants respectfully request withdrawal of the rejection of claims 11-17 and 25-37 under 35 U.S.C. §102(e) as being anticipated by the Joao patent.

## CONCLUSIONS

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

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